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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,458	07/13/2004	James Perry	81101886 / FMC 1769 PUS	4457
28395	7590	02/22/2006	EXAMINER	
BROOKS KUSHMAN P.C./FGTL 1000 TOWN CENTER 22ND FLOOR SOUTHFIELD, MI 48075-1238			ROSS, DANA	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/710,458	PERRY ET AL.	
	Examiner	Art Unit	
	Dana Ross	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/5/06; 7/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a second Non-Final Office action, in response to Applicant's Amendment dated 5 January 2006. Examiner inadvertently reversed the two cited prior art references in the rejections thereby causing Applicant to be unable to interpret the prior art rejections.

Information Disclosure Statement

2. Examiner is providing another copy of the initialed IDS filed by Applicant on 24 July 2004. Examiner did not initial in several areas in the previous office action.

Claim Rejections - 35 USC § 112

3. The rejection of the claims under 35 USC 112 is withdrawn due to Applicant's amendment filed 5 January 2006 and the identification of the embodiments that read on the claim 11 and 12.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 6-8, 15 and 16, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,593,258 (Matsumoto et al., hereafter '258).

'258 teaches a tool holder with a conduit with bore 7 having threaded interior sections 7a, 7b (see figure 1); an adjustment screw having a threaded body section 11a and a flange section 12 having a larger diameter than the threaded body section (see figure 1); the threaded body and flange sections defining an internal fluid passage (chamfered at area 20 of figure 1) disposed axially with the conduit (see col. 4, lines 51-56 and col. 6, lines 11-13, for example); a counter bore (see reference number 23, figure 1, for example, or reference numbers 22 or 20 of figure 1) disposed coaxially with the conduit for receiving a cutting tool 25; a sealing portion (see area of reference number 16, 18, 19 or 32 of figure 1) configured to inhibit fluid leakage between the flange section 12 and the end surface of the tool; recessed portion 20 (see figure 1).

6. Claims 6-8, 10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,004,382 (Yoshino, hereafter '382).

'382 teaches a tool holder (see figure 2, for example) with a conduit 3 having a threaded interior with a threaded adjustment screw 15 (see figure 1) with threads 16 (see figure 2) which engages the threaded interior section of the conduit 3, the screw 15 with a flange section having a larger diameter than the threaded body section of the screw 15 (see embodiment of reference

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number 35 of figure 4, for example); the threaded body and flange sections defining a chamfered internal fluid passage disposed axially with the conduit 3 (see figures 4 and 7, and col. 3, line 61 through col. 4, line 16, for example); a counter bore (see area of reference numbers 10 and 11 of figure 2, for example) disposed coaxially with the conduit 3; a sealing portion with a seal configured to inhibit fluid leakage between the flange section and the end surface (see col. 3, lines 22-24, for example); the adjustment screw 15 with a connection tube on the opposite end of the flange section (see area of reference number 40 of Figure 8) with the end portion of the tool with a recessed portion disposed proximate the fluid passage (see figure 8).

Examiner notes that the claims are replete with intended use limitations. Applicant is reminded that it has been held that the recitation that an element is “adapted to” perform or is “capable of” performing a function is not a positive limitation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over both '258 and '382.

Both '258 and '382 teach all aspects of claim 1.

Both '258 and '382 teach the use of seals.

Claims 8-14 are drawn to the various connection embodiments of figures 3A-3H, there being no criticality placed on any particular embodiment in Applicant's disclosure.

It would have been an obvious matter of design choice to make the different connection with grooves and male and female parts of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In this instance, there does not appear to be any criticality on any claimed shape. Furthermore, since Applicant has not disclosed that any particular claimed embodiment for a seal between two parts provides an advantage, is used for a particular purpose, or solves a stated problem, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with the seals of either '258 or '382 since the purpose of both the prior art and Applicant's invention is to provide a "seal" between to parts.

Allowable Subject Matter

9. The indicated allowability of the subject matter found in claims 9 and 11-14 is withdrawn in view of the newly discovered claimed embodiments clarified through Applicant's response on 5 January 2006.

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant was not able to determine how the two rejections applied to the two cited prior art references of the prior office action due to the examiner inadvertently switching the reference numbers.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



dmr



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER